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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,049	03/26/2004	Graziano Marusi	043001/0024 SBP/CEC/JEL	7895
7590	02/02/2009			EXAMINER NGUYEN, THONG Q
Steven B. Pokotilow Stroock & Stroock & Lavan LLP 180 Maiden Lane New York, NY 10038			ART UNIT 2872	PAPER NUMBER PAPER
			MAIL DATE 02/02/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/810,049	<b>Applicant(s)</b> MARUSI ET AL.
	<b>Examiner</b> Thong Nguyen	<b>Art Unit</b> 2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 October 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 30-40 and 42-60 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 30-40 and 42-55 is/are allowed.

6) Claim(s) 56-60 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The present Office action is made in response to the amendment filed on 10/9/2008. It is noted that in the amendment, applicant has made changes to the specification and the claims. Regarding to the claims, applicant has amended claims 30, 43-47 and 51; canceled claim 41 and added a new set of claims, i.e., claims 56-60, into the application. As a result, the pending claims are claims 30-40 and 42-60. Note that claims 1 and 3-29 were canceled in the amendment of 2/5/2008 and claim 2 was canceled in the amendment of 8/4/2006.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature related to the lens part shaped to be worn proximate a person's eyes as recited in claim 57, lines 3-4 must be shown or the feature canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The objection to the specification as set forth in the previous Office action has been overcome by the amendment to the specification as provided in the amendment of 10/9/2008.

4. The lengthy specification which was amended by the amendment of 10/9/2008 has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required.

The specification has not provided a proper antecedent basis for the following claimed features.

First, the feature thereof "a photochromic lens part constructed and shaped to be worn proximate a person's eyes" as recited in claim 57, lines 3-4;

Second, the feature thereof "the lens part having an inner surface facing the eyes and an outer surface facing outward away from the eyes" as recited in claim 57, lines 5-6;

Third, the feature thereof "wherein the sunglass, ophthalmic lens, visor or mask transmits light therethrough" as recited in claim 57, line 15; and

Fourth, the feature thereof "wherein the screen transmits light therethrough" as recited in claim 59, line 12.

***Claim Rejections - 35 USC § 112***

6. The rejection of claim 41 under 35 U.S.C. 112, first paragraph, as set forth in the previous Office action has been overcome by the cancellation of the claim as provided in the amendment of 10/9/2008.
7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 56-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matters which were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- a) Each of claims 55, 57 and 59 is rejected under 35 USC 112, first paragraph, because the disclosure as originally filed, does not provide support for the device as

claimed in each of claims 57 and 59. In particular, the disclosure, as originally filed, does not provide support for each of the claimed features.

First, the disclosure, as originally filed, does not support for the feature that the lens part comprising one or more photochromic dyes as claimed in each of claim 56 (lines 3, 5 and 7); claim 57 (line 7) and claim 59 (line 4). (examiner's emphasis). Applicant is respectfully invited to review the specification, in particular, paragraph [0015]. It is noted that while the mentioned paragraph discloses that there is a variety of materials can be sued for the production of photochromic lenses; however, the mentioned paragraph has NOT disclosed that the lens part comprising one or more photochromic dyes as claimed.

Second, the disclosure, as originally filed, does not provide support for the feature thereof "the film coating transmits an amount greater than 15% of spectral ultraviolet in a range between 315 and 400 nm" as claimed in each of claim 57 (lines 10-11) and claim 59 (lines 7-8). (examiner's emphasis). Applicant is respectfully invited to review the specification, in particular, paragraphs [0021], [0023], [0025], [0027] and [0029] which disclose that the film coating reflects an amount greater than 15% of spectral ultraviolet in a range between 315 and 400 nm. The specification has NOT discloses any information or description that the film coating transmits an amount greater than 15% of spectral ultraviolet in a range between 315 and 400 nm as claimed.

b) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiencies thereof.

***Claim Objections***

9. The objections to claims 30 and 46 as set forth in the previous Office action has been overcome by the amendment to the claims as provided in the amendment of 10/9/2008.

10. Claims 51 and 57 are objected to because of the following informalities. Appropriate correction is required.

- a) In claim 51: on line 3, "of a" should be changed to --of the--. Applicant should note that a lens part is recited on lines 2-3 of the claim; and
- b) In claim 57: on line 15, --lens—should be added after "sunglass". See line 1 of the claim.

***Allowable Subject Matter***

11. Claims 30-40 and 42-55 are allowed.

12. The following is a statement of reasons for the indication of allowable subject matter:

The light transmitting photochromic lens as recited in the independent claim 30 and the method for creating such a lens as recited in the independent claim 51 are patentable with respect to the prior art, in particular, the U.S. Patent Nos. 4,805,989; 6,175,450 and 4,852,974 by the limitations related to the structure of the lens. It is noted that the use of an interference film coated on a substrate is known to one skilled in the art as can be seen in the mentioned Patents; however, the prior art does not disclose a light transmitting photochromic lens comprises photochromic dyes and a multilayer thin film coating on an outer surface of the lens wherein the film reflects an amount less than

about 15% of spectral ultraviolet radiation in a range between 315 and 400 nm and reflects an amount equal to or greater than about 10% of light in the visible spectrum in a range between 410 and 800 nm so that the lens exhibits the visible colored appearance as claimed.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thong Nguyen/  
Primary Examiner, Art Unit 2872